

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte STEVEN T. KIRSCH

Appeal No. 2004-0873  
Application 08/927,022<sup>1</sup>

ON BRIEF

Before BARRETT, RUGGIERO, and DIXON, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-19.

We reverse.

<sup>1</sup> Application for patent filed September 10, 1997, entitled "Document Retrieval System With Access Control."

BACKGROUND

The invention relates to an electronic document retrieval method and system working with a search engine in which documents are stored in a distributed manner over a plurality of servers in a network. A user enters his identification number together with the query to be searched by the search engine. The search engine query server receives the question and interprets the query operators to find hits responsive to the question, where each hit is associated with an electronic document located at a URL. An access control list associated with the server lists the URLs for which the user has access. Before the list of hits is returned to the user, the hits are screened by comparing the user identification number to the access control list, and only those documents for which the user has access are returned to the user.

Claim 1 is reproduced below.

1. A document retrieval system with access control for a search engine capable of searching documents distributed over web servers in an electronic network comprising,

one or more web servers having electronic versions of documents said documents each having a security level, with each document available by request,

a search engine having access to all documents on the web servers, the documents associated with an access control list linking the security level of users with the security level of documents on the web servers, with the web servers screening the search results with the access control list to determine the documents for which a user performing a search has access.

THE REFERENCES

The examiner relies on the following references:

DuFresne	5,835,712	November 10, 1998 (filed May 3, 1996)
Haverstock et al. (Haverstock)	6,064,977	May 16, 2000 (filed June 19, 1998)

THE REJECTION

We refer to the final rejection (Paper No. 12) (pages referred to as "FR<sub>\_\_</sub>") and the examiner's answer (Paper No. 17) for a statement of the examiner's rejection, and to the appeal brief (Paper No. 21) (resubmission to include a statement of related appeals and interferences) (pages referred to as "Br<sub>\_\_</sub>") and reply brief (Paper No. 18) (pages referred to as "RBr<sub>\_\_</sub>") for a statement of appellant's arguments thereagainst.

Appellant notes (Br4) that the statement of the rejection of claims 1-8 and 11-18 is over DuFresne alone (FR2), but that the rejection also relies on Haverstock for independent claims 1 and 4 and, thus, claims 1-12 have actually been rejected over DuFresne and Haverstock. Appellant notes (Br4) that statement of the rejection of claims 9, 10, and 19 only mentions DuFresne (FR8), so these claims should be rejected over DuFresne alone. The examiner says nothing to clarify the rejections in the examiner's answer.

We agree with appellant that the stated rejection of claims 1-12 depends on Haverstock. Although Haverstock is not expressly

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mentioned in the rejection of claims 13-19, nor in the examiner's discussion of these claims in the examiner's answer, the rejection of claim 13 with respect to the limitation, "producing only those documents whose URL is compatible with the access level of the identification code of the person, wherein each non-compatible URL is withheld," refers to "previous responses" (FR6) which we interpret to be an indirect reference to Haverstock. Accordingly, we consider the rejection to be:

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over DuFresne and Haverstock.

#### OPINION

##### Grouping of claims

The examiner does not agree with appellant's statement that the claims do not stand or fall together (EA2-3). However, appellant has clearly stated that the claims do not stand or fall together (Br5) and has separately argued claims 1, 2, 4, 7, 8, 11, 12, 13, 15, and 16 (Br10-22). This complies with the requirements of 37 CFR § 1.192(c)(7), which was in effect at the time appellant's brief was filed. It is sufficient to separately consider only independent claims 1, 4, and 13.

##### Claims 1-3

The examiner finds that "DuFresne discloses the claimed invention except for the documents each having a security level,

with each document and preventing the user from discovering the existence of said document titles through the use of the search engine" (FR3). (It is noted that claim 1 does not expressly recite preventing the user from discovering the existence of documents, as in claims 2 and 4.) The examiner finds that Haverstock teaches that it was known to prevent the user from discovering the existence of document titles through the use of the search engine and concludes that it would have been obvious to prevent discovering the existence of titles in DuFresne as taught by Haverstock since "such a modification would allow the documents to be access controlled and specific objects can be secured and delivered only to specific users" (FR3).

The contents of DuFresne and Haverstock are fairly summarized by appellant at Br6-7.

Appellant argues that there is no suggestion to combine the references (Br9-10). We address the rejection assuming there is motivation to combine.

Appellant notes that claim 1 recites "a search engine having access to all documents on the web servers." It is argued that DuFresne does not disclose a search engine, but only discloses a client making a request for a particular Web page by entering a URL (Br11). The examiner finds that DuFresne discloses a search engine where scripts and forms are used to retrieve data from a database (EA3). Appellant argues that scripts and forms are not

"a search engine having access to all documents on the web servers" and "DuFresne is concerned with retrieving specific content/data from a database for a web page having a known URL, not with searching web servers to identify locations where documents relevant to the search, if any, may be" (RBr2).

We agree with appellant that DuFresne does not disclose "a search engine having access to all documents on the web servers." A search engine is software that searches for data based on some criteria. A browser for submitting a URL is not a search engine. The examiner is apparently applying DuFresne because it discloses that "each template is protected by the 'access control lists' (ACL's) 92, 93 to limit access to specified groups of authorized users" (col. 10, 9-11), but this one aspect of claim 1 does not address the search engine limitation. DuFresne does not describe a search engine for searching for documents.

Appellant also notes that claim 1 recites "screening the search results with the access control list to determine the documents for which a user performing a search has access." It is argued that DuFresne only returns one document, specified by a request for a particular Web page, and there is not a plurality of results that are screened (Br11). The examiner responds that the results are screened because the user is restricted from retrieving records by the access lists (EA3-4) and DuFresne produces a plurality of results as disclosed at columns 4, 8, 9,

and 11 (EA4). Appellant replies that DuFresne only controls access to records in a database and does not screen data record results (RBr2-3).

Since DuFresne does not search, it does not produce search results and, therefore, does not screen search results. The submission of a URL to a protected document is checked for access (col. 18, line 56, to col. 19, line 47), but the submission of a URL is not a search query that produces search results, so controlling access to a document in DuFresne does not meet the limitation of "screening the search results." Thus, even if DuFresne's decision on whether to return a template at a specified URL based on the access control list is considered a "screening," it is not "screening the search results."

Appellant still further notes that claim 1 recites "the documents associated with an access control list" and argues that in the "claimed invention a plurality of documents are associated with a single access control list, but the user never knows about documents to which he does not have access" (Br11-12), whereas in DuFresne the fetched template has two access control list fields so a user knows his access level (Br12). The examiner responds that the user not knowing his access level is not claimed (EA4).

We agree with the examiner that claim 1 does not recite that the user does not know his or her access level.

Appellant argues that Haverstock uses more than one access control list per document and Haverstock fails to teach or suggest where the access control lists are stored (Br12). The examiner states that claim 1 does not require only one access control list and DuFresne and Haverstock disclose that the access control list can be stored within the document (EA4-5).

We agree with the examiner that claim 1 is not limited to one access control list. Claim 1 does not recite where the access control list is stored, i.e., that, as disclosed, it is stored separately from the documents. However, claim 1 recites "documents [plural] associated with an access control list" and DuFresne shows the access control list(s) associated with only a single document. Thus, DuFresne does not teach this limitation.

For the reasons stated above, we conclude that the examiner has failed to establish a prima facie case of obviousness as to claim 1. The rejection of claim 1 and its dependent claims 2 and 3 is reversed.

Claims 4-12

The examiner finds (FR4) that DuFresne discloses claim 4 except for "preventing the person from discovering the URLs that are not compatible with the access level of the person." The examiner finds that Haverstock teaches that it was known to prevent the user from discovering the existence of documents and

apparently relies on the reasons stated for claim 1 to combine the teachings of DuFresne and Haverstock.

Appellant notes that claim 4 recites "executing a query ... yielding a list of all relevant documents, each document having a unique URL," and argues that, in DuFresne, a query is not executed, rather a URL address is inputted to retrieve a template (Br15). It is argued that in the present invention a query yields a list of all relevant documents corresponding to that query, each document having a unique URL, whereas in DuFresne, a URL yields the template specifically identified by that URL (Br15). The examiner finds that DuFresne discloses a search engine where scripts and forms are used to retrieve data from a database (EA6). Appellant argues (RBr5) that DuFresne discloses scripts and forms to retrieve data from a database to prepare a single document and not for "executing a query on a query server." It is also argued that a "list of all relevant documents" is not yielded in DuFresne (RBr6).

We find that DuFresne does not teach "executing a query" for the same reasons that DuFresne does not teach a "search engine" as discussed in the analysis of claim 1. Moreover, the result of DuFresne is the display of the URL page requested by the user, not production of a "list of all relevant documents" as claimed.

Appellant next notes that claim 4 recites "reviewing all URLs by the document servers after the search is executed using

an access control list associated with each document server to check whether each URL is compatible with the access level of the identification code of the person executing the query." It is argued that in DuFresne a user enters only one URL and, so, "all URLs" cannot be reviewed as there is only one URL (Br15). It is argued that each template in DuFresne contains its own access control lists, whereas in the claimed invention each document server is associated with a single access control list (Br15-16). The examiner finds this "reviewing" limitation taught "as stated previously above" (EA6).

We find that "reviewing all URLs" is not taught by DuFresne for the reasons discussed in connection with "screening the search results" in claim 1. There is only one document retrieved in DuFresne, the Web page having the URL entered by the user. DuFresne clearly does not teach generating a list of relevant documents and then reviewing that list using an access control list to determine compatibility as claimed. DuFresne only determines whether to provide access to a single document (the template). Furthermore, the access control list in DuFresne is associated with a document and is not "an access control list associated with each document server," as claimed.

Appellant notes that claim 4 recites "delivering only those URLs that are compatible with the access level of the person, wherein each URL that is not compatible with the access level of

the person is withheld." It is argued that in DuFresne only a single URL is entered and only a single document could be delivered (Br16). The examiner finds the limitation taught "as stated previously above" (EA6). Appellant responds that DuFresne is only concerned with user access to records in a database, not "delivering only those URLs that are compatible with the access level of the person" and in DuFresne a single URL request is entered and corresponds to only a single Web page (RBr7).

We find that DuFresne does not teach the limitation since it does not teach the preceding steps of generating a list of URLs by a search and reviewing it using an access level. Moreover, DuFresne only delivers the URL requested, not multiple URLs.

Lastly, it is noted that claim 4 recites "preventing the person from discovering the URLs that are not compatible with the access level of the person." Appellant relies on the reason stated for claim 2, i.e., in DuFresne the user is already aware of the existence of the document, as the user has entered in a URL corresponding to that document (Br13), whereas in appellant's invention only those document titles that the user has access to are forwarded to the user (Br13-14). The examiner finds this limitation taught "as stated previously above" (EA6). Appellant again relies on the arguments for claim 2 (RBr7-8).

We find that "preventing" is not taught by the combination of DuFresne and Haverstock for the reasons discussed by appellant in connection with claim 2.

For the reasons stated above, we conclude that the examiner has failed to establish a prima facie case of obviousness as to claim 4. The rejection of claim 4 and its dependent claims 5-12 is reversed.

Claims 13-19

The examiner's rejection combines the reasoning stated for claims 1 and 4, but does not expressly mention Haverstock (FR6).

Appellant notes that claim 13 recites "each document server having an access control list." It is argued that in DuFresne each template corresponding to a single document contains its own access control lists, whereas with the present invention, each document server (having multiple documents) has one access control list (Br20). The examiner states that it is not clear that claim 13 requires only one list, but permits that single or multiple control lists can be used (EA8-9).

We agree with the examiner that "an access control list" does not exclude additional access control lists. The "access control list" is not recited to be a separate list from the access control lists in the documents.

Appellant further notes that claim 13 recites "defining user identification and for each user identification listing URLs for

which access is permitted or denied." It is argued that DuFresne fails to teach or suggest the specific method by which it is determined whether users are permitted or denied access (Br20). The examiner states that DuFresne discloses permitting and denying access via the template and access control levels (EA9).

The issue is whether DuFresne discloses the claimed access method, not whether it discloses any access method. DuFresne discloses that it controls access to templates based on the access control lists; it seems that the access control list in each template is a list of user identifications. However, DuFresne does not disclose "for each user identification listing URLs for which access is permitted or denied."

Appellant notes that claim 13 recites "executing a query on a query server having access to a document index of documents available for searching on the document servers by a person having one of said identification codes." It is argued that this limitation is not taught for the reasons stated with regard to claim 4 (Br20). The examiner asserts that DuFresne discloses "the scripts, buttons, and CGI execute a query having access to a document index for searching wherein a database is inherently deemed to be indexed" (EA9). Appellant responds that DuFresne does not teach "executing a query," but is concerned with providing content for a document template, where the user knows of the existence of the document (RBr11). It is argued that the

user activates a known URL and does not query a server for relevant URLs (RBr11).

As we found for claim 4, DuFresne does not teach "executing a query" for the same reasons that DuFresne does not teach a "search engine" as discussed in the analysis of claim 1. In addition, DuFresne goes to a specified URL page requested by the user and has no need to search a "document index."

Appellant notes that claim 13 recites "determining by one of the document servers whether each URL is compatible with the access level of the identification code of the person." It is argued that only a single document is requested and produced in DuFresne and, so, there is no need to determine if each URL is compatible with the access level since only one URL is used and only one document is provided (Br21). It is argued that the claimed invention produces "documents" not a single document (Br21). The examiner finds that DuFresne discloses multiple documents being returned "as previously disclosed above" (EA9).

DuFresne only determines whether the single template at the URL is compatible with the access level, not whether "each URL" is compatible where there is a list of URLs.

For the reasons stated above, we conclude that the examiner has failed to establish a prima facie case of obviousness as to claim 13. The rejection of claim 13 and its dependent claims 14-19 is reversed.

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## CONCLUSION

The rejection of claims 1-19 is reversed.

REVERSED

*Lee E. Barrett*  
LEE E. BARRETT

LEE E. BARRETT  
Administrative Patent Judge

*Joseph Ruggirello*  
JOSEPH E. RUGGIRELLO

JOSEPH F. RUGGIERO  
Administrative Patent Judge

A handwritten signature in black ink, appearing to read "Joshua L. Dayton".

JOSEPH L. DIXON  
Administrative Patent Judge

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